

Remarks

Claims 1-49 were pending in the application and all the pending claims were rejected for the various reasons described in the Office Action and summarized below. The rejections are respectfully traversed. Claims 50-57 have been added. Claims 1, 22, 37, 50 and 54 are the independent claims.

The Examiner rejected claims 1-4, and 9-21 under 35 USC 103(a) as being unpatentable over admitted prior art and *Hendricks et al.* (US Publication 2003/0145323). The rejection is respectfully traversed.

Independent claim 1 is directed to an advertisement management system (AMS) for inserting targeted advertisements in an electronic program guide (EPG). The system includes an advertisement characterization module for characterizing one or more advertisements to be transmitted to a subscriber within the EPG. A subscriber characterization module characterizes one or more subscribers receiving the EPG. An EPG correlation module correlates the advertisements to the subscribers and selects the suitable advertisements for insertion in the EPG.

The Examiner appears to be asserting that since Applicant admits that advertisements are often presented in EPGs and that *Hendricks et al.* disclose targeting advertisements that the embodiment recited in claim 1 would be obvious in light thereof. Initially, the Applicant points out that the Examiner is merely combining two concepts (ads in EPGs and targeted advertising). The Examiner's motivation for combining the concepts appears to be that targeted advertising is beneficial. While it may be true that targeted advertising is beneficial, this generic motivation provided by the Examiner is not sufficient motivation for combining the admitted prior art and *Hendricks et al.*

The Examiner has pointed to nothing in either piece of prior art that would lead one to incorporate the teachings of the other piece of prior art. The admitted prior art simply discloses ads being displayed in an EPG and does not disclose or suggest targeted ads being displayed in the EPG. *Hendricks et al.* disclose delivering targeted ads to subscribers within feeder channels, where a STB switches channels to a feeder channel having an appropriate targeted advertisement

Amendment

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during advertisement opportunities in a program stream. *Hendricks et al.* do not disclose or suggest EPGs or ads in EPGs, let alone targeted ads in EPGs.

Moreover, it is unclear how combining the references would be beneficial. That is, it is unclear how delivering targeted ads in feeder channels could be used in an EPG or how an EPG could be used to deliver ads via the feeder channels.

Furthermore, even if we assume *arguendo* that there was some motivation to combine the references, the combination would still not result in the embodiment recited in claim 1. For example, neither reference discloses an EPG correlation module to select suitable advertisements for insertion in the EPG.

For at least the reasons noted above, it is submitted that claim 1 is patentable over the cited references. Claims 2-4 and 9-21 depend from claim 1 and are therefore submitted to be patentable over the cited references for at least the reasons advanced with respect to claim 1 and for the further features recited therein. Applicant respectfully submits that the rejection has been overcome and should accordingly be withdrawn and claims 1-4 and 9-21 should proceed to allowance.

The Examiner rejected claims 5-8 and 22-49 under 35 USC 103(a) as being unpatentable over admitted prior art, *Hendricks et al.* and *Macrae* (US Publication 2003/0208756).

Dependent claim 5 is directed to an advertisement management system (AMS) for inserting targeted advertisements in an electronic program guide (EPG). The system includes an advertisement characterization module for characterizing one or more advertisements to be transmitted to a subscriber within the EPG. A subscriber characterization module characterizes one or more subscribers receiving the EPG. An EPG correlation module correlates the advertisements to the subscribers and selects the suitable advertisements for insertion in the EPG. An EPG download server creates a plurality of EPG screens having targeted advertisements. The EPG with suitable advertisements is received by the subscriber at a subscriber interface.

The Examiner concedes that the combination of the admitted prior art and *Hendricks et al.* that is relied on for the rejections of claims 1-4 and 9-21 does not disclose or suggest a

download server, or a plurality of EPG screens having different targeted advertisements. The Examiner relies on *Macrae* for disclosing these features (paragraphs 218, 219 and 281). The Applicant submits that even assuming *arguendo* that there was motivation to combine the references (without acknowledging or conceding such) that the combination would not result in the embodiment recited in claim 5.

The Examiner does not rely on *Macrae* for disclosing the features noted above with respect to claim 1 that were absent from the teachings of the Examiner's combination (e.g., an EPG correlation module to select suitable advertisements for insertion in the EPG) and the Applicant submits that *Macrae* does not disclose these features of claim 1. Furthermore, the Applicant submits that *Macrae* does not disclose the additional features of claim 5 (e.g., a plurality of EPG screens having different targeted ads) as suggested by the Examiner. Rather, *Macrae* discloses delivering different ads in different portions of the EPG (one ad in a sports theme grid and a second ad in main menu grid, see para. 281). The ads in *Macrae* are targeted to the EPG screen viewed as opposed to the subscriber (no correlation of ad to subscriber) as recited in independent claim 1 and dependent claim 5.